

REMARKS

Claims 1-15 are pending, of which claims 1 and 11 are independent method claims with corresponding independent computer program product claims 10 and 15. As indicated above, claims 11-14 have been amended by this paper.¹

The Office Action rejected each of the pending independent claims (1, 10, 11, and 15) under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,668,169 to Burgan et al. ("*Burgan*"). The Office Action rejected the dependent claims under (i) 35 U.S.C. § 102(e) as being anticipated by *Burgan*, or (ii) under 35 U.S.C. § 103(a) as unpatentable over *Burgan* in view of either U.S. Patent No. 6,654,359 to La Porta et al. ("*La Porta*") or U.S. Patent No. 6,067,567 to Bartfai et al. ("*Bartfai*").²

Applicants' invention, as claimed for example in independent method claim 1, relates to acknowledging delivery of an instant message, where the criteria for determining success or failure of delivery are user specified. The method includes a sending computer system identifying user specified criteria for returning a successful acknowledgement message corresponding to the instant message to the user, determining whether the user specified criteria for returning a successful acknowledgement message are met, and returning a successful acknowledgement message corresponding to the instant message only if the user specified criteria have been met.

Similarly, Applicants' invention, as claimed for example in independent method claim 11, also relates to acknowledging delivery of an instant message, where the criteria for determining success or failure of delivery are user specified. The method includes a sending computer system receiving an acknowledgement message for the instant message, determining whether user specified criteria for returning a successful acknowledgement message corresponding to the received acknowledgement message for the instant message are met, and returning a successful acknowledgement message corresponding to the received acknowledgement message for the instant message only if the user specified criteria have been met.

¹The amendments to claims 11-14 simply add explicit claim language for limitations that were otherwise inherent in the claims. Accordingly, these amendments do not narrow the scope of the claims or otherwise evince an intent to surrender subject matter.

²Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of the cited art.

As Applicants point out, "[t]here are several circumstances in which a 'successful' acknowledgement message may be returned to [an] instant message sender. This ambiguity may leave the sender of the instant message somewhat confused as to the meaning of a 'successful' acknowledgement message." Specification, p. 3, l. 24 – p. 4, l. 3. In contrast, "embodiments of the present invention permit a user to specify the criteria for determining the success or failure of the transmission of an instant message. Since the user specifies the criteria, the user is well informed of the meaning of [a] successful acknowledgement message received in response to the transmission of an instant message." Specification, p. 5, ll. 2-6.

Burgan discloses real time communication among a plurality of wireless communication devices within a wireless communication system. Col. 1, ll. 14-17. The Office Action asserts that *Burgan*, at column 13, lines 14-50; column 7, line 43 – column 8, line 16; column 5, lines 40-45; and column 9, lines 28-60 discloses Applicants claimed invention. Office Action, p. 2-3 (rejection of claim 1); p. 4 (rejection of claim 10); p. 4-5 (rejection of claim 11); p. 8 (rejection of claims 12-15). Applicants respectfully disagree.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. "[F]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." MPEP § 706.02. Applicants also note that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure.'" MPEP § 2121.01. In other words, a cited reference must be enabled with respect to each rejected claim limitation.

At column 13, lines 14-50, *Burgan* discloses subscription to a new chat topic by a wireless communication device in connection with Figure 13. The wireless device queries for a new chat programming message, and if none is received returns to standby mode. If a chat programming message is received, the chat address for the chat topic is added to memory, a new chat inbox is created, and the wireless device sends an acknowledgement message to the chat server. Note, however, that at column 13, lines 14-50, there is no mention of a sending computer identifying user specified criteria for returning a successful acknowledgement message, or determining whether the user specified criteria are met, or returning a successful acknowledgement message only if the user specified criteria have been met. There is no mention

of user specified criteria for returning a successful acknowledgement message whatsoever. At best, this cited portion of *Burgan* simply teaches sending an acknowledge message in the first instance, as opposed to determining whether a given acknowledge message represents a successful acknowledge message based on user specified criteria. Moreover, column 13, lines 14-50, of *Burgan* certainly is not enabling with respect to the rejected claim language. In other words, based on column 13, lines 14-50, an Examiner would not have allowed *Burgan* to submit Applicants' recited claim language.

At column 7, line 43 – column 8, line 16, *Burgan* discloses the operation of a chat server in connection with Figure 6. The chat server queries whether a request for a chat list has been received, and if not the chat server returns to standby mode. If a request for a chat list has been received, the chat server sends a list of active chats to the requestor. The chat server also queries whether a topic subscription request has been received from a subscriber, and if not the chat server again returns to standby mode. If a topic subscription request has been received, the chat server checks whether the subscriber account is active, and if so, adds the user to the subscriber list for the requested topic. If the requested topic includes a guaranteed delivery option, the chat server queries for a user acknowledgement receipt when the chat server sends a programming message for programming a new inbox at a wireless communication device. When the chat server has received the user acknowledgement, the requesting user is activated in the requested chat topic.

Once again, note however that at column 7, line 43 – column 8, line 16, there is no mention of a sending computer identifying user specified criteria for returning a successful acknowledgement message, or determining whether the user specified criteria are met, or returning a successful acknowledgement message only if the user specified criteria have been met. There is no mention whatsoever of user specified criteria for returning a successful acknowledgement message. At best, this cited portion of *Burgan* simply teaches receiving an acknowledge message when a guaranteed delivery option is associated with a requested chat topic, as opposed to determining whether a given acknowledge message represents a successful acknowledge message based on user specified criteria. Here too, column 7, line 43 – column 8, line 16 of *Burgan* certainly is not enabling with respect to the rejected claim language. In other words, based on column 7, line 43 – column 8, line 16, an Examiner would not have allowed *Burgan* to submit Applicants' recited claim language.

At column 5, lines 40-45, *Burgan* discloses a user profile that may include billing information, favorite topics, associates, group lists, age, obscenity rating, and optional services. The chat server sends a chat notification when a new chat corresponding to the user profile is initiated. As above, note however that at column 5, lines 40-45, there is no mention of a sending computer identifying user specified criteria for returning a successful acknowledgement message, or determining whether the user specified criteria are met, or returning a successful acknowledgement message only if the user specified criteria have been met. In fact, there is no mention of user specified criteria for returning a successful acknowledgement message whatsoever. At best, this cited portion of *Burgan* simply teaches sending a chat notification when new chat that meets the user profile is initiated, as opposed to determining whether a given acknowledge message represents a successful acknowledge message based on user specified criteria. Again, column 5, lines 40-45 of *Burgan* certainly is not enabling with respect to the rejected claim language. In other words, based on column 5, lines 40-45, an Examiner would not have allowed *Burgan* to submit Applicants' recited claim language.

At column 9, lines 28-60, *Burgan* discloses a chat memory for a wireless communication device in connection with Figures 8 and 9. The chat memory includes a memory slot for the chat topic to which the wireless communication device subscribes. A plurality of chat messages associated with the chat topic are stored in chronological order. The chat memory may include chat preferences that define the options chosen by the user for a chat topic, such as an alert option on receipt of a new chat message, guaranteed delivery, timeout, the number of chat messages to retain in history, and a subscription timer.

Yet again, note however that at column 9, lines 28-60, there is no mention of a sending computer identifying user specified criteria for returning a successful acknowledgement message, or determining whether the user specified criteria are met, or returning a successful acknowledgement message only if the user specified criteria have been met. There is no mention whatsoever of user specified criteria for returning a successful acknowledgement message. At best, this cited portion of *Burgan* simply teaches various chat preferences, as opposed to determining whether a given acknowledge message represents a successful acknowledge message based on user specified criteria. Here as well, column 9, lines 28-60 of *Burgan* certainly is not enabling with respect to the rejected claim language. In other words, based on

column 9, lines 28-60, an Examiner would not have allowed *Burgan* to submit Applicants' recited claim language.


Accordingly, Applicants respectfully submit that *Burgan* fails to anticipate the pending independent claims because *Burgan* fails to teach each and every element set forth in claims 1, 10, 11, and 15. Therefore, the rejection of independent claims 1, 10, 11, and 15 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

Based on at least the foregoing reasons, therefore, Applicants respectfully submit that the cited prior art fails to anticipate or make obvious Applicants invention, as claimed for example, in independent claims 1, 10, 11, and 15. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertion with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 3rd day of May, 2004.

Respectfully submitted,



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